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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,686	10/29/2001	Constantine N. Anagnostopoulos	83230AEK	9910

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EXAMINER.

SCHWARTZ, PAMELA R

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 08/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,686

Applicant(s)

ANAGNOSTOPOULOS ET AL.

Examiner

Pamela R. Schwartz

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-23 and 26-33 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 26-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 9 and 11-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-9, 11-23 and 26-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, 11-23 and 32, drawn to a medium, classified in class 428, subclass 32.1.
 - II. Claims 26-31 and 33, drawn to a method of use, classified in class 347, subclass 105.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and of Group II are related as product and process of use.

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different method such as a method of painting with a brush comprising applying paint to the surface of the medium with a paint brush.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: 1) choose between a) one with a plan cross section that is circular (cl 4) and b) one with a plan cross section that is rectangular, square, etc. (cl 6); 2) choose from a) a hydrophilic base (cl 7, 32) and b) a hydrophobic base (cl 8, 9); and 3) choose one UV absorber from those disclosed in claims 12-15.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-3, 5, 11 and 16-23 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Mr. Kluegel on August 6, 2003 a provisional election was made with traverse to prosecute the invention of Group I, species conforming to claims 6, 8, 9 and 14. Affirmation of this election must be made

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by applicant in replying to this Office action. Claims 4, 7, 12, 13, 15 and 26-33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

It is noted that upon further review, applicants have admitted on page 8 of the specification that the UV absorbers of claims 12-15 are all well known for such use. Consequently, they are considered to be obvious over one another and that portion of the election of species is hereby withdrawn. In addition, determination of the plan cross section appears to be an obvious variant to one of ordinary skill in the art (see W) 00/73082), consequently, both claims 4 and 6 will be examined. Therefore, claims 1-6 and 11-23 are generic, claims 8 and 9 are directed to the elected species and will also be examined, and claims 7 and 26-33 are withdrawn from further consideration.

2. Claims 1-6, 8, 9, and 11-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 10/039,441. Although the conflicting claims are not identical, they are not patentably distinct from each other because they all recite a medium comprising a support having a three dimensional array of cells on the surface thereof. All of the instant claim limitations appear to be recited by the claims of the other application except for the thickness of the fused layer and the fused cell wall material. It would have been obvious to one of ordinary skill in the art to determine the thickness of the predetermine array upon heating so that a sufficient overcoat is provided so that the image is protected and to use common fusible materials such as polyethylene as the fusible material of the cell walls.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claim 1-6, 8, 9, and 11-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/046024. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the other application are directed to the method of making the instantly claimed article and recite or obviate all of the instant claim limitations. It would have been obvious for one of ordinary skill in the art to determine a regular cross section for the cells, a known UV absorber, and a thickness of the overcoat layer once fused after imaging so that the material would serve a protective function.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. It is noted that only every other page of the patent documents submitted by applicants with their information disclosure statement were found in the file. Consequently, these documents have not been fully considered but will be considered upon submission of complete copies of the references. Full copies of the non-patent literature were received.

Claims 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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The term "free radical quencher" is not well known in this art, nor is it defined by applicants' specification. Consequently, the specification is not enabling with respect to this feature. The examiner believes that applicants may be referring to materials such as antioxidants that are commonly used in the ink jet recording arts. Therefore, for purposes of making a rejection over the prior art, the examiner has made the assumption that a "free radical quencher" is an antioxidant.

5. Claims 1-6, 8, 9 and 11-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ylitalo et al. (WO 00/73082). Please refer to the description of this reference included in Paper No. 5. Ylitalo et al. disclose a microembossed receptor medium for ink jet ink (see the abstract). The reference discloses microembossing that is random in one aspect, but may be, therefore, the cross section of the embossures may be random or regular (see page 6, lines 25-30 and page 7, lines 11-15). The embossing may have a variety of geometries (see p. 10, lines 28-30 and p. 11, lines 1-7). The cavities formed are enclosed by walls and are closely packed together (see p. 11, lines 19-20). The material of the walls may be polyolefin and the cells may be coated with an ink receptive coating (see p. 12, line 26 to page 14, line 5). The reference states that these coatings may include those that are known in the art. They may include surfactants, including those that would act as pigment stabilizers, and mordants for dyes. The reference does not appear to disclose the inclusion of a UV absorber or an antioxidant, however, these are well known additives in the art for their concomitant functions. Therefore, it would have been obvious to one of ordinary skill in the art to include these materials in the ink medium of the reference.

Based upon the dimensions of the cell walls disclosed by the reference on page 11, the examiner maintains the position that the thermoplastic cell walls of the reference could be fused to form a coating over one micron in thickness. Finally, the reference refers to temperatures beginning at about 100 °C for the press mold and extruder used to form the microembossed surface. Therefore, it would have been obvious to one of ordinary skill in the art to utilize material for the cell walls that is capable of being fused below this temperature. At the very least, applicants' limitation of "less than 100°C" is not sufficiently different from the temperatures disclosed in the prior art formation processes to render applicants article patentably distinct.

6. Applicant's arguments with respect to claims 1-6, 10 and 20-23 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela R. Schwartz whose telephone number is 703-308-2424. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on (703) 308-0449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


PAMELA R. SCHWARTZ
PRIMARY EXAMINER

PRSchwartz
August 16, 2003